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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,449	04/30/2001	Tomio Kondou	64859 CCD	2494

7590

04/16/2003

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EXAMINER

DOE, JANIS L

ART UNIT

PAPER NUMBER

1756

10

DATE MAILED: 04/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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Below is a communication from the EXAMINER in charge of this application
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 8 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 707.07(f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 4/2/03. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (see NOTE below);
- (b) ☐ they raise the issue of new matter. (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE:

4. ☒ Applicant's reply has overcome the following rejection(s):
see attached, paragraph 1.
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached, paragraph 2
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: _____
- Claim(s) objected to: _____
- Claim(s) rejected: 1-11, 23, 24
- Claim(s) withdrawn from consideration: _____
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
11. ☒ Other: see attached.

Janis L. Dote
JANIS L. DOTE
PRIMARY EXAMINER
GROUP 1504

1700

1. The objection to the specification under 35 U.S.C. 132 set forth in the final rejection mailed Oct. 2, 2002, Paper No. 7, paragraph 3, has been withdrawn for all the reasons set forth by applicants in the response filed after the final rejection in Paper No. 9 on Apr. 2, 2003, page 2, and their filing of a verified English-language translation of their priority document, Japanese patent application No. 2000-133980, in Paper No. 9 on Apr. 2, 2003. The instant application at page 39, lines 21-23, incorporates by reference said priority document.

Applicants have perfected their claim to foreign priority under 35 U.S.C. 119, by the filing of the verified English-language translation of the priority document, Japanese patent application No. 2000-133980, for the subject matter recited in instant claims 1, 2, and 4-7. Therefore, Japanese Patent 2000-199982 (JP'982) is not prior art to those claims.

Applicants have not indicated where in the translation the translation provides antecedent basis for the subject matter recited in instant claims 3, 8-11, 23, and 24. Moreover, the examiner could not find an adequate written description of the subject matter recited in instant claims 3, 8-11, 23, and 24, as set forth under 35 U.S.C. 112, first paragraph. For example, the translation does not disclose that the color toners have a melt viscosity not greater than "about 120 mPas·sec at 140°C" (emphasis added) as recited in instant claim 3. Rather, the

translation discloses that the color toners have a melt viscosity not greater than "120 mPas·sec at 140°C." See the translation, page 1, line 20, and page 6, line 4. The value of "about 120 mPas·cm" is broader than the disclosed value of 120 mPas·cm in the translation, because it includes values that are about 120 mPas·cm. Thus, the subject matter recited in claims 3, 8-11, 23 and 24 are not entitled to the benefit of priority under 35 U.S.C. 119. Accordingly, JP'982 is prior art with respect to those claims, and the following 35 U.S.C. 103(a) rejections over JP'982 stand:

(1) The rejection of claims 3, 10, and 23 over US 5,805,969 (Elsermans) combined with JP'982, as evidenced by the JPO translation of JP'982, set forth in Paper No. 7, paragraph 4;

(2) The rejection of claim 3 and 8 over US 4,593,991 (Aoki) combined with US 5,521,688 (Moser) and JP'982, as evidenced by the JPO translation of JP'982, set forth in Paper No. 7, paragraph 8;

(3) The rejection of claims 3, 9, 23, and 24 over US 5,442,428 (Takahashi) combined with Moser and JP'982, as evidenced by the JPO translation of JP'982, set forth in Paper No. 7, paragraph 10; and

(4) The rejection of claims 3 and 11 over US 6,188,418 B1 (Hata) combined with Moser and JP'982, as evidenced by the JPO translation of JP'982, set forth in Paper No. 7, paragraph 12.

2. Applicants' arguments filed after the final rejection in Paper No. 9 have been fully considered but they are not persuasive for the reasons set forth in the final rejection in Paper No. 7, paragraph 14. As discussed in Paper No. 7, the reasons to combine the references do not have to be those of applicants. Accordingly, the combination of references cited in Paper No. 7, paragraphs 4-13, renders prima facie obvious the instantly claimed method and apparatus.

Furthermore, as discussed in the final rejection in Paper No. 7, paragraph 14, the showing in the instant specification is not commensurate in scope with the instant claims because instant examples 1-4 comprise combinations of preferred embodiments recited in dependent claims 2-7, which are not recited in independent claims 1 and 23. Contrary to applicants' statement that the specification does not disclose examples 1-4 as preferred, the instant specification discloses that the limitations recited in instant claims 2-7 are preferred because the color toners comprising said respective embodiments have good or improved color reproducibility. Specification, page 8, line 23, to page 9, line 2; page 9, lines 17-23; page 10,

line 25, to page 11, line 4; page 12, lines 19-21; and page 39, lines 5-19. Thus, it is not clear whether the improved results in color reproducibility are obtained from the color toners comprising only the particular yellow and magenta pigment recited in instant claims 1 and 23, or obtained by some combination of the preferred embodiments, which is narrower in scope than any dependent claim. "It is well settled 'that objective evidence of non-obviousness must be commensurate in scope with the claims which the evidence is offered to support.' In re Tiffin, 448 F.2d 791, 171 USPQ 294 (CCPA 1971)." In re Grasselli, 218 USPQ 769, 778 (Fed. Cir. 1983). The burden is on applicants, who are asserting unexpected results, to come forward with showings that the evidence on which they rely extend over the entire scope of the claimed subject matter.

Moreover, applicants' comments that JP'982 cannot be relied as a showing that "the results in the specification do not appear to be unexpected" because JP'982 is not prior art are not persuasive. As discussed in paragraph 1, supra, JP'982 is prior art with respect to instant claims 3, 8-11, 23, and 24, and its teachings still apply.